

### Remarks/Arguments

Applicant has carefully considered the office action mailed September 3, 2008, and submits the foregoing amendments and the following remarks.

#### Rejection of claims 1 and 11 as obvious over *Jahier v. Berlowitz* and/or *Wittenbrink*

The examiner rejects claims 1-10 as obvious under 35 U.S.C. § 103 over EP 0 789 203 A1 to *Jahier et al* ("Jahier") in combination with U.S. Patent No. 5,689,031 to *Berlowitz et al* ("Berlowitz") or U.S. Patent No. 6,296,757 to *Wittenbrink* ("Wittenbrink").

#### Response

The U.S. Court of Appeals for the Federal Circuit (the "Federal Circuit") recently affirmed that, "**a flexible TSM test remains the primary guarantor against a non-statutory hindsight analysis**" of the issue of obviousness. *Ortho-McNeil Pharmaceutical, Inc. v. Mylan Laboratories, Inc.*, 86 U.S.P.Q.2d 1196, 1201-02 (Fed. Cir. 2008). The examiner has not met the flexible TSM test.

The examiner has not pointed to a teaching or suggestion in any of the cited references of **a process for reducing corrosion in a condensing boiler burning liquid fuel**. The examiner has not pointed to a teaching or suggestion to reduce corrosion in a condensing boiler burning liquid fuel by "supplying liquid fuel comprising Fischer-Tropsch derived fuel to the condensing boiler." Claim 11. The examiner certainly has not pointed to a teaching or suggestion that "the liquid condensate" produced burning fuel comprising Fischer-Tropsch derived fuel in a condensing boiler would comprise "a reduced iron content compared to the iron content produced by combusting an industrial gas oil fuel using the same condensing boiler under the same conditions." Claim 11. Nor has the examiner established that "the liquid condensate" would comprise "a reduced nickel content" compared to "the nickel content produced by combusting an industrial gas oil fuel using the same condensing boiler under the same conditions." Claim 35.

For the foregoing reasons, the examiner has not met the flexible TSM test. *Id.* The examiner has not established that the claims are directed merely to "**the predictable use of prior art elements according to their established functions**," *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. \_\_\_\_\_, 127 S.Ct. 1727, 82 U.S.P.Q.2d 1385, 1396 (U.S. 2007)

RECEIVED  
CENTRAL FAX CENTER

JAN 28 2009

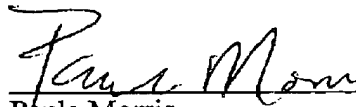
(emphasis added). Nor has the examiner established that Berlowitz and/or Wittenbrink provide an **apparent reason to combine known elements** in the fashion claimed. *Id.* (emphasis added).

Applicant respectfully requests entry and allowance of the new claims over the cited references.

### CONCLUSION

For all of the foregoing reasons, Applicant respectfully requests entry and allowance of the new claims. The examiner is hereby authorized to charge any fees, and to deposit any overpayment of fees, to Deposit Account No. 19-1800 (File no. TS8578), maintained by Shell Oil Company

Respectfully submitted,



Paula Morris

The Morris Law Firm, P.C.

P. O. Box 420787

10777 Westheimer, Suite 1100

Houston, TX 77242-0787

Phone: 713/334-5151

FAX: 713/334-5157

[pmorris@morrisiplaw.com](mailto:pmorris@morrisiplaw.com)

[www.morrisiplaw.com](http://www.morrisiplaw.com)

ATTORNEY FOR APPLICANT